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| 10/797,839      | 03/10/2004  | John R. Blake        | 47171-00390USPT     | 5664             |

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| EXAMINER |
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MCCLAIN, GERALD

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3653

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 02/28/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/797,839

Applicant(s)

BLAKE ET AL.

Examiner

Gerald W. McClain

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 25-32 is/are pending in the application.
- 4a) Of the above claim(s) 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 25-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election **with** traverse of Species E in the reply filed on 27 December 2006 is acknowledged. The traversal is on the ground(s) that a prima facie case supporting restriction has not been set forth and that the restriction requirement is internally flawed and suspect. This is not found persuasive because the species requirement has been changed according to a telephone conversation with William Pegg on 20 February 2007: ~~Species A: Figure 1-3.~~ Species B: Figure 4a-4c. Species C: Figure 5a-5c. ~~Species D: Figure 4a-4c.~~ Species E: Figure 6-8. Species F: Figure 9. Regarding the prima facie case supporting restriction, according to the cited MPEP section (808.02(C)), a burden is set forth when the Examiner must "[employ] different search queries". Therefore, the original prima facie case supporting restriction stands.

Further, regarding the assertion that the restriction requirement is internally flawed and suspect, Species A and D have been withdrawn from the restriction requirement so that the requirement is now valid.

The requirement is still deemed proper and is therefore made FINAL.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16 and 25-31, drawn to a coin processing device, classified in class 453, subclass 13.

- II. Claim 32, drawn to a method for manufacturing a coin processing device based on the needs of a customer, classified in class 194, subclass 350.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as manufacturing the device by using knowledge obtained by a journal.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with William Pegg on 20 February 2007 a provisional election was made without traverse to prosecute the invention of I, claims 1-16 and 25-31 (because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a))). Affirmation of this election must be made by applicant in replying to this Office action. Claim 32 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Objections***

Multiple claims are objected to because of the following informalities: the terms "coin" and "receptacle(s)", when they are used together as a compound adjective sometimes have a dash between them, as in Claim 25 and sometimes do not as in Claim 1. They should be drawn consistently. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 5, 12, 27, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, the limitation "disk-type" with the term "type" renders the claim indefinite. *Ex parte Cocenhaver*, 109 USPQ 118 (Ed. App. 1955).

Claim 1 recites the limitation "lower surface" in line 6. There is insufficient antecedent basis for this limitation in the claim. It is unclear what structure is being limited.

Claim 1 recites the limitation "movement" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "coin processing device" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "exits" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is unclear to what the term "exits" refers. Is the term referring to the "exit channels" of Claim 8?

Claim 27 recites the limitation "group" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 29 recites the limitation "telescoping handle" in line 2. There is insufficient antecedent basis for this limitation in the claim. The last four-word phrase of the Claim is an extraneous repeat of the previous phrase since the "telescoping handle" is already recited.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-5, 7-9, 14-16, and 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Hino, et al. (US 2002/0162724) ("Hino").

Claim 1: housing (See FIG. 2, 110); disk-type coin sorter (S); input hopper (112); rotatable disk (2); stationary head (1); lower surface ([0137]); shaped regions (10); exit channels (8a to 8c); coin receptacle station (120); coin receptacles (124a to 124j); first position (FIG. 2); second position (FIG. 4); manifold (location of 152); coin paths (152);

Claim 2: casters (122b);

Claim 4: dampening mechanism (See FIG. 4 below, C and 122a); coin receptacle station (120); first end (See FIG. 4 below, C); housing (110); second end (See FIG. 4 below, Back Side (opposite Front Side) of 122a);

Claim 5: housing (See FIG. 2, 110); coin processing device (inside 110); coin processing unit (S); coin receptacles (124a to 124j); coin receptacle station (120); moveable platforms (122); first position (FIG. 2); second position (FIG. 4);

Claim 7: coin processing unit (S); disk-type coin sorter (S); exit channels (8a to 8c);

Claim 8: manifold (location of 152); coin paths (152); exit channels (8a to 8c); coin receptacles (124a to 124j);

Claim 9: coin receptacles (124a to 124j); coin bins (124a to 124j);

Claim 14: housing (See FIG. 2, 110); door (122a); open position (FIG. 4); closed position (FIG. 2); moveable platform (122);

Claim 15: door (122a); rear side (See FIG. 4 below, D); housing (See FIG. 2, 110);

Claim 16: door (122a); front side (See FIG. 4 below, D; Note: the location of D can be defined as the rear or front side); housing (See FIG. 2, 110);

Claim 25: receiving a plurality of coins of a plurality of denominations to be sorted (112; paragraph [0135]);

sorting the plurality of coins according to denomination with the coin sorting unit (S; paragraph [0130]);

directing (10) sorted coins to the plurality of coin receptacles (124a to 124j), each coin receptacle containing coins of a single denomination (paragraphs [0131] to [0134]);

moving (122) one of the coin-receptacle platforms from the first position (FIG. 2) to the second position (FIG. 4) for accessing the coin receptacles (paragraph [0136]);

Claim 26: opening a door (122a) of the housing prior to moving the one of the coin-receptacle platforms from the first position the second position (paragraph [0136]);

Claim 27: housing (See FIG. 2, 110); coin processing device (inside 110); coin sorting unit (S); coin receptacle area (area taken by 120); coin receptacle station (120); coin receptacles (124a to 124j); moveable platforms (122); first position (FIG. 2); second position (FIG. 5); moveable coin bin (the enclosed space of 124a to 124j); interior (the enclosed space of 124a to 124j);

Claim 28: moveable coin bin (the enclosed space of 124a to 124j); wheels (122b).



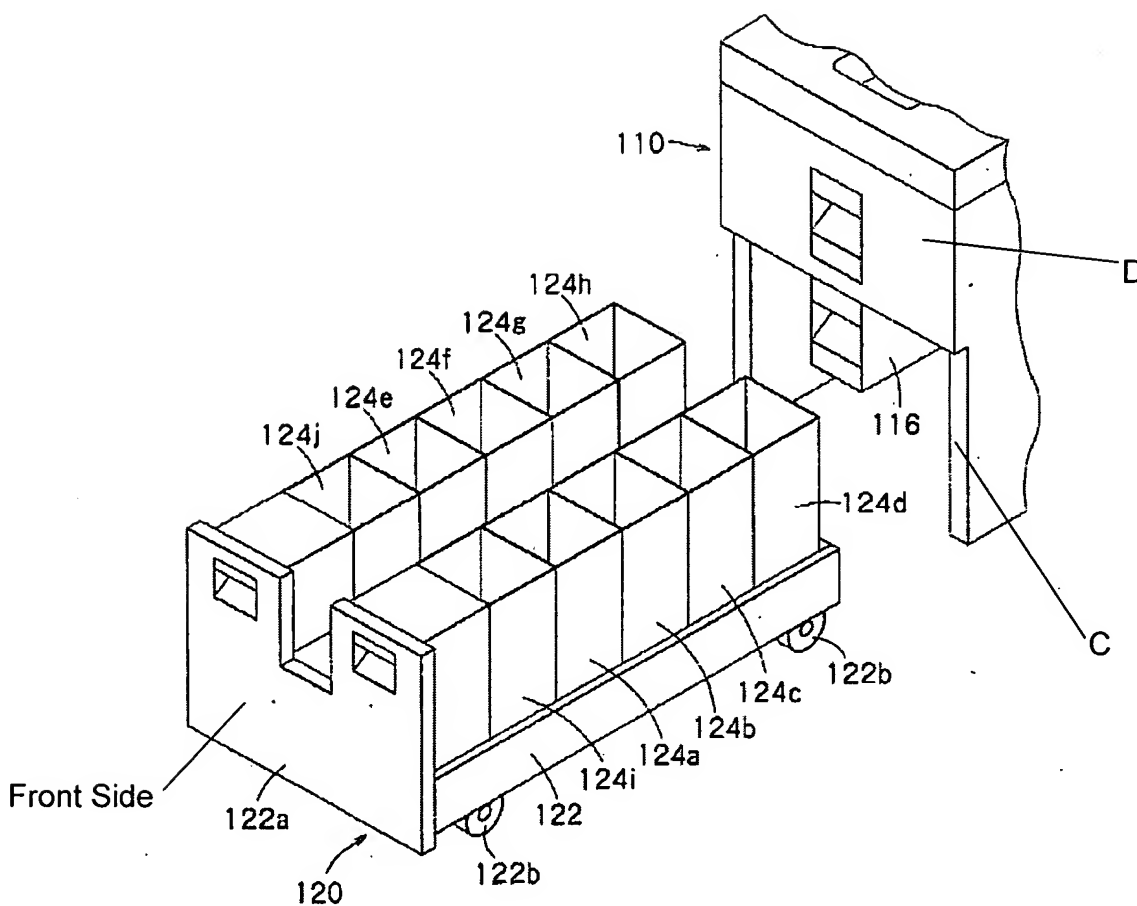


FIG. 4

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 10, 12-13, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hino in view of Jones, et al. (US 6,318,537) ("Jones"). Hino teaches all the limitations of the claims as discussed above. Hino does not directly show coin bags or coin bag holders.

Jones shows a similar device having a coin bags (52) and coin bag holders (58) for the purpose of holding the sorted coins of a specific denomination (column 2, lines 25-28). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify Hino as taught by Jones and include Jones' similar device having a coin bags and coin bag holders for the purpose of holding the sorted coins of a specific denomination:

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hino in view of Muellner (US 4,450,968). Hino teaches all the limitations of the claims as discussed above. Hino does not directly show a track.

Muellner shows a similar device having a track (24) for the purpose of receiving and capturing the casters (column 2, lines 57-66). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify Hino as taught by Muellner and include Muellner's similar device having a track for the purpose of receiving and capturing the casters.

Claims 11 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hino in view of Jones. Hino teaches all the limitations of the claims as discussed above. Hino does not directly show a coin bag partition.

Jones shows a similar device having a coin bag partition (44) for the purpose of sorting coins of various denominations (column 2, lines 25-28). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify Hino as taught by Jones and include Jones' similar device having a coin bag partition for the purpose of sorting coins of various denominations.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hino in view of Alexander, et al. (US 2002/0134645) ("Alexander"). Hino teaches all the limitations of the claims as discussed above. Hino does not directly show a telescoping handle.

Alexander shows a similar device having a telescoping handle (213) for the purpose of allowing for more comfortable operation of the device (paragraph [0031]). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention to modify Hino as taught by Alexander and include Alexander's similar device having a telescoping handle for the purpose of allowing for more comfortable operation of the device.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald W. McClain whose telephone number is (571)

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272-7803. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gerald W. McClain  
Examiner  
Art Unit 3653



DAVID H. BOLLINGER  
PRIMARY EXAMINER 2/27/07